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Date: DECEMBER 1, 2005

To: EXAMINER SWEARINGEN, JEFFREY R.
U.S. PATENT AND TRADEMARK OFFICE

Fax #: (571) 273-8300

From: FRANK C. NICHOLAS
Phone #: (847) 424-2521

Client/Matter No.: AUS920010444US1 (9000/48)

of Pages: 7
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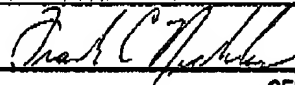
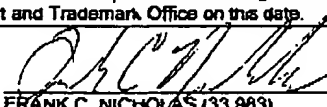
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TRANSMITTAL FORM <small>(to be used for all correspondence after initial filing)</small>	Attorney Docket No	AUS920010444US1 (8000/48)
	Application Number	09/096,130
	Filing Date	NOVEMBER 28, 2001
	First Named Inventor	DAVID B. KUMHYR
	Group Art Unit	2145
	Examiner	SWEARINGEN, J. R.

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Amendment <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Status Letter <input type="checkbox"/> One-Month Petition for Extension of Time Request (dup) <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Supplemental Information Disclosure Statement, PTO-1449, art <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> Assignment Papers <input type="checkbox"/> Drawings <input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition <input type="checkbox"/> To Convert a Provisional Application <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Express Abandonment Under 37 CFR 1.138 <input type="checkbox"/> Request of Refund	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Reply Brief (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Post Card Receipt <input type="checkbox"/> Additional Enclosure(s) (please identify below) <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/>
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Total		Minus		0	x \$25=	0	x \$50=	
Indep.		Minus		0	x \$100=	0	x \$200=	
First Presentation of Multiple Dep. Claim					+ \$180=	---	+ \$360=	
					total add'l fee		total add'l fee	
					\$ 0		\$ 0	

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm or Individual name	FRANK C. NICHOLAS Registration No. 33,883 CARDINAL LAW GROUP 1603 Orrington Avenue, Suite 2000 Evanston, IL 60201		
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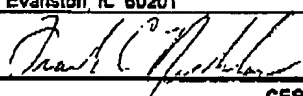
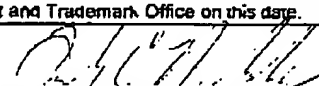
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TRANSMITTAL FORM (To be used for all correspondence after initial filing)	Attorney Docket No	AUS920010444US1 (900048)
	Application Number	09/996.130
	Filing Date	NOVEMBER 28, 2001
	First Named Inventor	DAVID B. KUMHYR
	Group Art Unit	2145
	Examiner	SWEARINGEN, J. R.

ENCLOSURES (check all that apply)		
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				Small Entity		Large Entity		
	Claims After Amendment		Highest No Previously Paid For	Present Extra	Rate	Add'l Fee	Rate	Add'l Fee
Total		Minus		0	x \$25=	0	x \$50=	
Indep.		Minus		0	x \$100=	0	x \$200=	
First Presentation of Multiple Dep. Claim					+ \$180=	-	+ \$360=	
					total add'l fee	\$ 0	total add'l fee	\$ 0

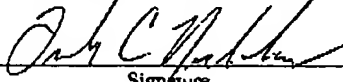
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Firm or Individual name	FRANK C. NICHOLAS Registration No. 33,983 CARDINAL LAW GROUP 1603 Orrington Avenue, Suite 2000 Evanston, IL 60201		
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PATENT
Case No. AUS920010444US1
(9000/48)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:

DAVID B. KUMHYR, ET AL.

Serial No.: 09/996,130

Filed: NOVEMBER 28, 2001

Title: ALLOCATING DATA OBJECTS
STORED ON A SERVER SYSTEM

Examiner: SWEARINGEN, JEFFREY R.

Group Art Unit: 2145

Conf. No.: 1438

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22202-1450

Dear Sir:

Appellants respectfully present their Reply Brief on Appeal as follows:

December 1, 2005
Case No. AUS920010444US1 (9000/48)
Serial No.: 09/996,130
Filed: November 28, 2001
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Appellants maintain their traversal of the §103(a) rejections of claims 1-21 as unpatentable over Herz in view of Jacobs. Obviousness under §103(a) simply cannot be established without providing evidence of the motivating force which would impel one skilled in the art to do what the applicants have done. Ex Parte Levengood, 28 USPQ2d 1300 (BPAI 1993). While it is true that the motivation of the references need not be the same as Applicants', there *must be motivation* to make the claimed invention.

The Examiner continues to erroneously argue, in substance, that one of ordinary skill in the art would be motivated to combine a system utilizing a cache (Jacobs) to cache documents that have been tagged (Herz). Even if the Examiner had correctly summarized the teachings of each document, there is no motivation to combine the references. The cited "aiding a user in accessing data in a rapid manner" is entirely summary and non-specific. Since this is the Examiner's best (indeed only) argument for a motivation to combine, the Examiner's use of impermissible hindsight is clear – only by looking back based on Applicants' teachings could the Examiner make such an argument.

The motivation to combine references can only come from the references, be reasoned from common knowledge in the art, or from legal precedent. "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." MPEP §2143.01. In this case, the Examiner makes no showing that the motivation to combine the references comes from the references or that the motivation comes from legal precedent. Thus, the Examiner appears to be relying on "common knowledge in the art" – however, the Examiner *makes no showing of what knowledge is common in the art*, such as with official notice or an Examiner's Affidavit. As the motivation cannot come from the level of skill in the art, the Examiner needs to show *facts*, not allegations, to support that it is common knowledge in the art to combine these references. In view of the Examiner's failure to make such a showing, the §103(a) rejection must fall.

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And, even if there were a motivation to combine, the combination does not teach or suggest "determining whether the tag information corresponds to the group interest, and if there is correspondence, placing data objects including tag information of said group interest into a server cache," as claimed. As Applicants have previously noted, Jacobs (on which the Examiner relies) teaches a system and method for customizing cached data including a method for configuring data that *is to be cached* (i.e., the computer already knows that a piece of data is going to be cached) rather than a method of determining *whether* to cache a piece of data. See, ¶31 of the May 4, 2005 office action. Therefore, Jacobs cannot combine with any reference, much less Herz, to teach determining whether the tag information corresponds to the group interest and if there is correspondence placing data objects including tag information of said group interest into the cache as claimed in claims 1, 11, and 21. The teachings of Jacobs do not address determining whether to cache information, and therefore, Jacobs teaches away from the claimed elements.

Appellants request withdrawal of the rejections to independent claims 1, 11, and 21, as well as claims 2-10 and 12-20 depending directly or indirectly from independent claims 1 and 11 respectively.

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CONCLUSION

The Examiner's rejections have been obviated by the above remarks. Appellant respectfully submits that claims 1-21 fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. In view of the foregoing remarks, favorable consideration and passage to issue of the present application are respectfully requested.

Dated: **DECEMBER 1, 2005**

Respectfully submitted,
DAVID B. KUMHYR, *et al.*

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